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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/602,010	06/23/2003	Bruce Edward Stuckman	1033-T00531	7678

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EXAMINER

BASHORE, WILLIAM L

ART UNIT PAPER NUMBER

2176

DATE MAILED: 07/27/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/602,010

Applicant(s)

STUCKMAN ET AL.

Examiner

William L. Bashore

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 May 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 3 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-36 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This action is responsive to communications: Amendment filed 5/4/2006, to the original application filed 6/23/2003, IDS filed 10/20/2003.
2. Claims 1-36 pending. Claims 35-36 have been added by Applicant. Claims 1, 24 are independent.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Utsumi, Yoshimasa (hereinafter Utsumi), European Patent No. EP 1 160 708 A1, published December 5, 2001, in view of BountyQuest Website (hereinafter BountyQuest), <www.bountyquest.com>, 5/15/2001, downloaded via archive.org on 11/1/2005, pages 1-29 (listed in a previous action – please note that the examiner references page numbers at bottom of the BountyQuest reference).

In regard to independent claim 1, Utsumi teaches a method of assessing possible patent infringement (Utsumi Abstract, para [0013]) whereby information is posted on a Website seeking possible infringement information regarding a particular patent, etc. (Utsumi para [0023], [0024], [0025]). If a user wishes to input a possible infringement target, he/she can do so via an input form (Utsumi para [0027], [0028], [0029], [0030]).

Utsumi teaches an input form field for inputting detailed infringement information (Utsumi para [0030] window 23). Said window 23 is offered for input of infringement target information, with the size of said

window providing the capability of inputting as much information as may be necessary. It is also noted that Figure 3 “Patent Number” (upper left corner) is carried over from Utsumi Figure 2 item 15, at least providing criteria for infringement via at least the display of the patent number itself on the form of Figure 3. Utsumi also teaches an embodiment which allows solicitation of opinions (Utsumi para. [0064]). Utsumi does not specifically teach a second user input to describe how said target meets the criteria, or of indication of an infringement target. However, BountyQuest teaches an input form for a user to enter information, including multiple areas for describing how the infringement target meets the criteria (BountyQuest, page 16 section “Required Elements”). Above this is an input window indicating “The article clearly describes a device for changing hot lightbulbs with the hinges described in claim 5 of the...” (BountyQuest page 16 “Description/Comments”). The examiner fairly interprets this teaching as directed to the user identifying an infringement target, or at the very least associated with an infringement issue (see also BountyQuest page 9, top paragraph). It would have been obvious to one of ordinary skill in the art at the time of the invention to apply BountyQuest to Utsumi, providing Utsumi a detailed way to solicit a contributing opinion in the form of an infringement description and target. Both references are in the same general field of endeavor, since both references deal with solicitation of prior art, and both deal in the realm of IP infringement (see BountyQuest page 9, top paragraph).

In regard to dependent claim 2, Utsumi teaches input boxes (Utsumi Figure 3). Utsumi does not specifically teach a plurality of input boxes for the second input. However, BountyQuest teaches an input form for a user to enter information, including multiple input boxes for describing how the infringement target meets the criteria (BountyQuest, page 16 section “Required Elements”). It would have been obvious to one of ordinary skill in the art at the time of the invention to apply BountyQuest to Utsumi, providing Utsumi a detailed way to solicit a contributing opinion in the form of an infringement description in an organized manner. Both references are in the same general field of endeavor, since both references deal with solicitation of prior art, and both deal in the realm of IP infringement (see BountyQuest page 9, top paragraph).

In regard to dependent claim 3, Utsumi teaches input boxes (Utsumi Figure 3). Utsumi does not specifically teach a plurality of input boxes for the second input, each box differentiated accordingly. However, BountyQuest teaches an input form for a user to enter information, including multiple input boxes for describing how the infringement target meets the criteria, one box per limitation (BountyQuest, page 16 section “Required Elements”). It would have been obvious to one of ordinary skill in the art at the time of the invention to apply BountyQuest to Utsumi, providing Utsumi a detailed way to solicit a contributing opinion in the form of an infringement description in an organized manner. Both references are in the same general field of endeavor, since both references deal with solicitation of prior art, and both deal in the realm of IP infringement (see BountyQuest page 9, top paragraph).

In regard to dependent claim 4, Utsumi teaches input boxes (Utsumi Figure 3). Utsumi does not specifically teach a plurality of areas displaying infringement criteria portions, with each input box differentiated accordingly. However, BountyQuest teaches an input form for a user to enter information, including multiple input boxes for describing how the infringement target meets the criteria, one box per displayed infringement limitation (BountyQuest, page 16 section “Required Elements”). It would have been obvious to one of ordinary skill in the art at the time of the invention to apply BountyQuest to Utsumi, providing Utsumi a detailed way to solicit a contributing opinion in the form of an infringement description in an organized manner. Both references are in the same general field of endeavor, since both references deal with solicitation of prior art, and both deal in the realm of IP infringement (see BountyQuest page 9, top paragraph).

In regard to dependent claims 5-6, Utsumi teaches input boxes (Utsumi Figure 3). Utsumi does not specifically teach a plurality of areas displaying infringement criteria portions (claim limitations), with each input box differentiated accordingly. However, BountyQuest teaches an input form for a user to enter information, including multiple input boxes for describing how the infringement target meets the criteria, one

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box per displayed infringement limitation (BountyQuest, page 16 section “Required Elements”). It would have been obvious to one of ordinary skill in the art at the time of the invention to apply BountyQuest to Utsumi, providing Utsumi a detailed way to solicit a contributing opinion in the form of an infringement description in an organized manner (i.e. columnar fashion, etc.). Both references are in the same general field of endeavor, since both references deal with solicitation of prior art, and both deal in the realm of IP infringement (see BountyQuest page 9, top paragraph).

In regard to dependent claims 7-8, Utsumi teaches an input box for inputting infringement information in natural language text (Utsumi’s Figure 3 accepts natural (i.e. English, etc.) language input).

In regard to dependent claims 9-11, Utsumi teaches a Web form (Utsumi para [0027]). Utsumi teaches identification of a product, and a company (Utsumi para [0006], [0028]).

In regard to dependent claim 12, Utsumi teaches a submission judged (evaluated) by a server management company (Utsumi para [00028]).

In regard to dependent claims 13-17, Utsumi teaches judgment by a patent attorney (Utsumi para [0037]). A reward is issued for a first on-point submission accordingly, along with deals, fixed and/or variable fees etc. (Utsumi para [0037] to [0041]).

In regard to dependent claims 18, Utsumi teaches submission via e-mail, which contains a date and time stamp. It would have been obvious to one of ordinary skill in the art at the time of the invention to apply a date and time stamp of submission, providing the benefit of timely submissions in case of disputes, etc.

In regard to dependent claim 19, Utsumi does not specifically teach a receipt. However, BountyQuest teaches recordation of a session ID and timestamp, as well as instructions to print a copy of the confirmation page (BountyQuest page 15). It would have been obvious to one of ordinary skill in the art at the time of the invention to apply BountyQuest to Utsumi, providing Utsumi the benefit of receipts for confirming submissions.

In regard to dependent claims 20-21, Utsumi teaches a suitable network (Utsumi para [0049], Figure 4 item 3). Although an “intranet” is not specifically disclosed, Utsumi does teach said network as the Internet (Utsumi para [0024]), providing reasonable suggestion to one of ordinary skill in the art at the time of the invention to utilize an intranet instead (intranet is contained, while the Internet is global), providing the benefit of increased security for seeking infringement of classified patents, etc.

In regard to dependent claim 22, although Utsumi does not specifically teach “graphical” input, nevertheless, Utsumi teaches nearly any type of communication mechanism for reporting information, including e-mail (Utsumi para [0051]). Since it is well established that e-mail has the capacity of attaching files (i.e. a pdf file, which is an image based document, diagrams, etc.), it would have been obvious to one of ordinary skill in the art at the time of the invention to provide graphical input such as diagrams and/or pdf as an e-mail attachment, providing the benefit of allowing a wide range of input from various sources.

In regard to dependent claim 23, Utsumi teaches multiple languages (Utsumi para [0026], Figure 2).

In regard to independent claim 24, claim 24 reflects the article of manufacture comprising computer readable instructions used for performing the methods as claimed in claim 1, and is rejected along the same rationale.

In regard to dependent claims 25-34, claims 25-34 reflect the article of manufacture comprising computer readable instructions used for performing the methods as claimed in claims 2-9, 22-23, respectively, and are rejected along the same rationale.

In regard to dependent claim 35, Utsumi teaches an account number input screen whereby an information provider inputs a bank account number or a credit card number of said information provider – “the number representing the account to which a consideration or a contingent fee for the provided information is transferred...” (Utsumi column 5 paragraph [0030]). Although Utsumi never recites a “*trust mechanism*”, nevertheless, this limitation would have been obvious to one of ordinary skill in the art at the time of the invention, in view of Utsumi’s disclosure above. Since it is well established that credit card numbers are typically used for charging purposes, the providing of a credit card number at least suggests a form of “trust management”. It is well within reason that the inputting of personal sensitive information such as bank numbers and credit card numbers can act as a deterrent against non-serious junk submissions. The implementation of such a deterrent provides the benefit of saving time and resources by not having to screen through non-useful information.

In regard to independent claim 36, claim 36 incorporates substantially similar subject matter as claimed in claim 1, and in further view of the following, is rejected along the same rationale.

Utsumi does not specifically recite “*wherein the infringement target information does not predate the filing date of the particular patent*”. However, this limitation would have been obvious to one of ordinary skill in the art at the time of the invention, in view of the following. Utsumi teaches its invention with regard to infringement (Utsumi Abstract). It is well established in U.S. Intellectual Property law that the above quoted limitation is at least a basic rule of infringement. Infringement of a patent can only occur if the “infringement target information” does not predate the filing date of said patent., therefore, it would have been obvious to one

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of ordinary skill in the art at the time of the invention to incorporate this well known rule, providing the benefit of patent rights enforcement.

Response to Arguments

5. Applicant's arguments filed 5/4/2006 have been fully and carefully considered but they are not persuasive.

Applicant argues on pages 7-8 of the amendment that BountyQuest teaches patent invalidation, as opposed to Utsumi's patent infringement embodiment. Applicant asserts that the combination of the two references would at least render the system unsatisfactory for its purpose of enabling efficient enforcement of patents.

The examiner respectfully disagrees. Applicant ignores BountyQuest's teaching (page 9 top paragraph – referenced in the instant rejections) which recites in pertinent part: *"Lawyers whose clients have been sued or threatened with suit for patent infringement post in order to find prior art that may help them defend a case."* Since infringement suits can be staggeringly high, it is well within reason that a patent rights holder can attempt to find both infringement targets, and information that may invalidate its own patent. The success of an infringement suit is based at least in part on the strength of the infringed patent against invalidation. If the inventor can find prior art to invalidate its own patent, this would save the inventor/company the expense of a full infringement suit, only to have the opposing party bring forward the same prior art.. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to BountyQuest with Utsumi as explained in the instant rejections.

Applicant argues on pages 9-10 of the amendment that Utsumi teaches two different Web pages for entering information, as opposed to Applicant's claimed limitation of *"An electronic form...etc."*

The examiner respectfully disagrees. In additional support to the instant rejections, it is also noted that Figure 3 "Patent Number" (upper left corner) is carried over from Utsumi Figure 2 item 15, at least providing criteria for infringement via at least the display of the patent number itself on the form of Figure 3.

Conclusion

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to William L. Bashore whose telephone number is (571) 272-4088. The examiner can normally be reached on 11:30am - 8:00pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather Herndon can be reached on (571) 272-4136. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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8. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

William L Bashore
WILLIAM BASHORE
PRIMARY EXAMINER

July 23, 2006